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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,270	05/15/2001	Hirohiko Hirai	MAT-8128US	9157
7590	11/17/2004			
RATNER AND PRESTIA One Westlakes, Berwyn Suite 301 P.O. Box 980 Valley Forge, PA 19482-0980			EXAMINER LETT, THOMAS J	
			ART UNIT 2626	PAPER NUMBER

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/855,270	HIRAI ET AL.	
	Examiner	Art Unit	
	Thomas J. Lett	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 3 is objected to because of the following informalities: the phrase "specific thumbnail from the thumbnail" should be changed to read "specific thumbnail from the thumbnails". Appropriate correction is required.
2. Claim 13 is objected to because of the following informalities: the phrase "the list of the thumbnail" should be changed to read "the list of the thumbnails". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6 and 11-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Yokoyama (US Patent 6,166,826).

With respect to claim 1, Yokoyama discloses an image data input unit 21 capable of scanning images (col. 7, lines 14-15), which reads on a scanner for capturing an image;

image data can also be input to the printing apparatus 1 with a memory card storing the image data (col. 7, lines 22-24), which reads on a memory card reader for loading and unloading a memory card and reading image data from said memory card;

as shown in FIG. 3, the printer 200 is comprised of an operation portion 202, which reads on an operating unit;

Examiner notes that a modem for transmission and communication is an inherent feature of the facsimile, which reads on a modem for modulating and demodulating image information into and from the data that can be transmitted and received through a communication line;

the image processing section 35 reads the file stored in the storage unit 37, converts the file into bit image data, and converts the bit image data into a compressed file format (col. 8, lines 56-59), which reads on an image data format converter for converting image data read out from said memory card into data in a format for a facsimile transmission; and

a print control section 33 controls the operation of the print engine 34. The print engine 34 prints on a print recording medium (col. 8, lines 39-43), which reads on a printing unit for printing, according to an instruction from said operating unit an image corresponding to the image data read out from said memory card, an image corresponding to the image data received through said communication line, and the image captured by said scanner.

With respect to claim 2, Yokoyama discloses an image data list file as shown in FIG. 9 (thumbnails) is prepared and can be printed, which reads on said printing unit

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prints, according to said operating unit, a thumbnail corresponding to the image data read out from said memory card.

With respect to claim 3, Yokoyama discloses the web browser 44 interprets the image data list file and displays the file on the monitor 45 as they are placed as shown in FIG. 9 (col. 11, line 66 – col. 12, line 1), which reads on a display for displaying the thumbnail corresponding to the image data read out from said memory card; and

then, the web browser 44 lists print images of the files in correspondence with the file names on the monitor, whereby the user can check the print images of several selected candidate files and specify any desired file (col. 12, lines 8-12), which reads on a controller operable to: select a specific thumbnail from the thumbnail displayed on said display with said operating unit; and make said printing unit print an image corresponding to the specific thumbnail. Examiner also notes that it is also well-known in the art that any image or thumbnail may be printed from a web browser.

With respect to claim 4, Yokoyama discloses the web browser 44 lists print images of the files in correspondence with the file names on the monitor, whereby the user can check the print images of several selected candidate files and specify any desired file (col. 12, lines 8-12), which reads on said controller is operable to select to print the image corresponding to the specific thumbnail after said printing unit prints the thumbnail, and to print the image corresponding to the specific thumbnail without printing the thumbnail by the printing unit after said display displays the thumbnail. Examiner notes that the user can choose to print the thumbnail from the web browser prior to printing the full image.

With respect to claim 5, Yokoyama discloses the "print data preparation unit 10" corresponds to a host computer, such as a personal computer or a personal digital assistants (PDA) (col. 6, lines 5-7) and Examiner notes that it is well known in the art that computers/PDAs contain numeric keys that can be used for control functions, which reads on said operating unit comprises numeric keys for specifying the specific thumbnail.

With respect to claim 6, Yokoyama discloses an image data file transfer request is issued to display the selected files (12C). The image data file transfer unit 5B transfers the requested image data file to the read unit 12 in response to the image data file transfer request. The image data file is displayed, so that the user can select the file to be reprinted (12D) (col. 6, lines 20-25), which reads on a display displays a detailed image corresponding to the specific thumbnail if said operating unit specifies the specific thumbnail, and wherein said printing unit prints the detailed image according to an instruction from said operating unit.

With respect to claim 11, Yokoyama discloses that image data can also be input to the printing apparatus 1 with a memory card storing the image data (col. 7, lines 22-24), which reads on a memory card reader for loading and unloading a memory card and reading image data from said memory card;

the printer 31 is provided with the web server section 39 and the web browser 44 is installed in the host computer 41 for executing two-way communication (col 13, lines 34-37), which reads on a receiver for receiving image information through a communication line;

the image processing section 35 reads the file stored in the storage unit 37, converts the file into bit image data, and converts the bit image data into a compressed file format (col. 8, lines 56-59), which reads on an image data format converter for converting image data read out from said memory card into data in a format for a facsimile transmission; and

the printer 31 has a print control section 33 controlling the operation of the print engine 34. The print engine 34 prints on a print recording medium (col. 8, lines 39-43), which reads on a printing unit for printing an image corresponding to the image data read out from said memory card, and an image data corresponding to the image information received through said communication line.

With respect to claim 12, Yokoyama discloses an image data list file as shown in FIG. 9 (thumbnails) is prepared and can be printed, which reads on said printing unit prints, according to said operating unit, a thumbnail corresponding to the image data read out from said memory card.

With respect to claim 13, Yokoyama discloses the web browser 44 interprets the image data list file and displays the file on the monitor 45 as they are placed as shown in FIG. 9 (col. 11, line 66 – col. 12, line 1), which reads on a display for displaying the list of the thumbnail corresponding to the image data read out from said memory card; and

then, the web browser 44 lists print images of the files in correspondence with the file names on the monitor, whereby the user can check the print images of several selected candidate files and specify any desired file (col. 12, lines 8-12), which reads on

a controller operable to make said printing unit print an image corresponding to the specific thumbnail selected from the list of the thumbnails displayed on said display means. Examiner also notes that it is also well-known in the art that any image or thumbnail may be printed from a web browser.

With respect to claim 14, Yokoyama discloses the web browser 44 lists print images of the files in correspondence with the file names on the monitor, whereby the user can check the print images of several selected candidate files and specify any desired file (col. 12, lines 8-12), which reads on said controller is operable to select to printing the image corresponding to the specific thumbnail after said printing unit prints the thumbnail, and to print the image corresponding to the specific thumbnail without printing the thumbnail after said display displays the thumbnail. Examiner notes that the user can choose to print the thumbnail from the web browser prior to printing the full image.

With respect to claim 15, Yokoyama discloses the "print data preparation unit 10" corresponds to a host computer, such as a personal computer or a personal digital assistants (PDA) (col. 6, lines 5-7) and Examiner notes that it is well known in the art that computers/PDAs contain numeric keys that can be used for control functions, which reads on said operating unit comprises numeric keys for specifying the specific thumbnail.

With respect to claim 16, Yokoyama discloses an image data file transfer request is issued to display the selected files (12C). The image data file transfer unit 5B transfers the requested image data file to the read unit 12 in response to the image data

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file transfer request. The image data file is displayed, so that the user can select the file to be reprinted (12D) (col. 6, lines 20-25), which reads on a display displays a detailed image of the specific thumbnail, and wherein said printing unit prints the detailed image.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7, 8, 10, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokoyama (US Patent 6,166,826) in view of Dow et al (US Patent 6,441,927).

With respect to claim 7, Yokoyama does not disclose that an image data format converter converts the image data stored in said memory card into data conforming to the ITU-T T.81 Standard. Dow et al discloses a method of using a common format used for encoding images is the JPEG standard (T.81 standard); however, other public or proprietary standards can be used with equal success (col 6, lines 9-12). Yokoyama and Dow et al are analogous art because they are from the similar problem solving area of data conversion. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the public or proprietary formatting standards feature of Dow et al to the system of Yokoyama in order to obtain image formatting or

compression or conversion. The motivation for doing so would be to convert image information.

With respect to claim 8, Yokoyama does not disclose that an image data format converter converts the image data stored in said memory card into first data conforming to the ITU-T T.81 Standard, and second data conforming to a modified Huffman (MH) code, and wherein said operating unit selects one of the first and second data. Dow et al discloses that in the preferred embodiment, CCITT-G4, which is designed for facsimile usage and black and white images, is used. Dow discloses that other methods could be used, and Examiner notes that it would be an obvious alternative to use modified Huffman for the black/white data (col. 6, lines 9-12). Yokoyama and Dow et al are analogous art because they are from the similar problem solving area of data conversion. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the public or proprietary formatting standards feature of Dow et al to the system of Yokoyama in order to obtain image formatting or compression or conversion. The motivation for doing so would be to convert image information.

With respect to claim 10, Yokoyama does not disclose that an image data format converter converts JPEG image data in a JFIF format of TIFF into data conforming to the ITU-T T.81 Standard. Dow et al discloses a method of using a common format used for encoding images is the JPEG standard (T.81 standard); however, other public or proprietary standards can be used with equal success (col. 6, lines 9-12). Yokoyama and Dow et al are analogous art because they are from the similar problem solving area

of data conversion. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the public or proprietary formatting standards feature of Dow et al to the system of Yokoyama in order to obtain image formatting or compression or conversion. The motivation for doing so would be to convert image information.

With respect to claim 17, Yokoyama does not disclose an image data format converter for converting the image data stored in said memory card into data conforming to the ITU-T T.81 Standard. Dow et al discloses a method of using a common format used for encoding images is the JPEG standard (T.81 standard); however, other public or proprietary standards can be used with equal success (col 6, lines 9-12). Yokoyama and Dow et al are analogous art because they are from the similar problem solving area of data conversion. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the public or proprietary formatting standards feature of Dow et al to the system of Yokoyama in order to obtain image formatting or compression or conversion. The motivation for doing so would be to convert image information.

With respect to claim 19, Yokoyama does not disclose an image data format converter for converting a JPEG image data in a JFIF format of TIFF into data conforming to the ITU-T T.81 Standard. Dow et al discloses a method of using a common format used for encoding images is the JPEG standard (T.81 standard); however, other public or proprietary standards can be used with equal success (col. 6, lines 9-12). Yokoyama and Dow et al are analogous art because they are from the

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similar problem solving area of data conversion. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the public or proprietary formatting standards feature of Dow et al to the system of Yokoyama in order to obtain image formatting or compression or conversion. The motivation for doing so would be to convert image information.

5. Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokoyama (US Patent 6,166,826) in view of Naruse et al (US Patent 4,985,919).

Yokoyama does not disclose that a memory card is a secure digital (SD) memory card. Naruse et al discloses a method of using a secure memory card 130 for facsimiles, for transmission of images over a network (col. 5, lines 1-3). Yokoyama and Naruse et al are analogous art because they are from the similar problem solving area of secure memory card use. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the secure facsimile memory card feature of Naruse et al to the system of Yokoyama in order to obtain secure image communication. The motivation for doing so would be to protect image data.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is 703-305-8733. The examiner can normally be reached on 7-3:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Any response to this action should be mailed to:

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or Faxed to:

(703) 872-9314 (for Technology Center 2600 only).

Hand-delivered responses should be brought to:

Crystal Park II

2121 Crystal Drive

Arlington, VA

Sixth Floor (Receptionist).

TJL



KAWilliams
KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER